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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/981,840	10/17/2001	Phillip W. Barth	10003813-1	8468
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7590 02/07/2006  
AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
P.O. Box 7599  
Loveland, CO 80537-0599

EXAMINER
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NORRIS, JEREMY C

ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/981,840

**Applicant(s)**

BARTH ET AL.

**Examiner**

Jeremy C. Norris

**Art Unit**

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 19-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-39 is/are allowed.
- 6) ☒ Claim(s) 1,2,8-17 and 22-30 is/are rejected.
- 7) ☒ Claim(s) 3 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8, 13-17, 22, and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,297,967 (Baumberger).

Baumberger discloses, referring primarily to figures 5 & 6, a flexible circuit comprising; a substrate (55) having a topside and plane; a flexible and extensible structure (61) formed within said substrate and co-planar with said substrate, said substrate having a structure topside; and wherein said structure is extendable out of said plane by a distance greater than a maximum lateral dimension of said structure (col. 6, lines 5-15 and col. 7, lines 40-45, such that said structure topside continues to face in a general topside direction (figure 6) [claim 1], further comprising an insulated pathway formed on said structure (61, is insulated from the elements by a nickel gold layer col. 7, lines 50-65) [claims 2, 17], wherein said structure is a spiral (figure 5) [claims 8, 22], wherein said structure has geometric features selected from a group comprising spiral, bend, curve, twist, turn, curl, loop, u-turn and zigzag (see figure 12) [claims 13, 27], wherein said structure is defined by dashed perforations (col. 6, lines 1-15) [claims 14, 28], wherein said structure comprises a boss for receiving a force to extend said structure out of said plane (col. 7, lines 35-50) [claims 15, 29], further

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comprising at least a first insulated pathway and a second insulated pathway (61, figure 6) [claims 16, 30].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9-12 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baunberger.

Regarding claims 9-12 and 23-26, Baunberger does not specifically disclose that the spiral comprises an Archimedes spiral, a parabolic spiral, a polygonal spiral, a square spiral, a triangular spiral, a pentagonal spiral or a hexagonal spiral. However, each one of these shapes is well known and a trivial variant of the generic "spiral" disclosed by the modified invention of Baunberger. As such, one of ordinary skill in the art would be motivated to use any one of these well-known shapes as the "spiral" in the modified invention of Baunberger. The motivation for doing so would have been to use simple variants also easy to manufacture. Moreover, it has been held that more than a mere change of form is necessary for patentability. *Span-Deck, Inc v. Fab-con, Inc.* (CA 8, 1982) 215 USPQ 835.

#### ***Allowable Subject Matter***

Claims 37-39 are allowed.

Claims 3 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 3 states the limitation "wherein said pathway is a capillary for transferring a fluid". This limitation, in conjunction with the other claimed features, was neither found to be disclosed in nor suggested by the prior art. Claim 18 states the limitation "wherein

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said insulated pathway is a capillary for transferring a fluid". This limitation, in conjunction with the other claimed features, was neither found to be disclosed in nor suggested by the prior art. Claim 37 states the limitation "a capillary for transferring fluid on said structure". This limitation, in conjunction with the other claimed features, was neither found to be disclosed in nor suggested by the prior art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 8-17, and 22-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

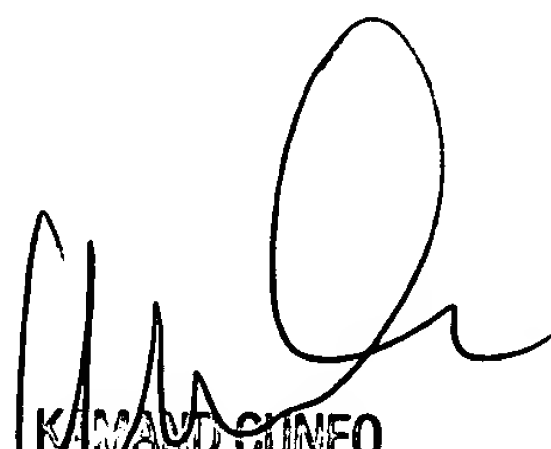
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 571-272-1932. The examiner can normally be reached on Monday - Friday, 9:30 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JCSN



KAMAND CUNEO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800